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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/890,055 | 09/12/2002 | Urs Wuest | 7524.23USWO | 5754 |

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| EXAMINER | |
|---|---|
| SORKIN, DAVID L | |
| ART UNIT | PAPER NUMBER |
| 1723 | |

DATE MAILED: 03/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/890,055 | WUEST ET AL. | |
| | Examiner | Art Unit | |
| | David L. Sorkin | 1723 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *16 February 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *8-15* is/are pending in the application.

4a) Of the above claim(s) *14 and 15* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *8-13* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election with traverse of Group I in the reply filed on 16 February 2005 is acknowledged. The traversal is on the grounds that the examiner has not shown that examination of both groups would be "overly burdensome". While applicant has not pointed out a basis for an "overly burdensome" standard for restriction, examination of both groups would be overly burdensome for the following reasons:

a. Whereas the method claims (Group II) are limited to process involving flour, "inclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims" *In re Otto* 136 USPQ 458, 459 (CCPA 1963). Thusly, Group I can be anticipated by references entirely unrelated to "flour".

b. Furthermore the "filters" required by group I are not required by Group II. Group II, unlike group I, could be anticipated by reference not disclosing a filter, or only disclosing a single filter.

c. Also, the valve system of Group I is not required by Group II.

d. Also, the treatment/clearing with air of Group II is not required by Group I.

e. Also, while Group I requires "devices" for adding additive, Group II does not even require one such device. In group II additives could be added by hand or with a single such device.

f. Also, the discharge equipment required by group I is not required by Group II.

2. The requirement is still deemed proper and is therefore made FINAL.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 8-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Wayne (US 3,519,431). Regarding claim 8, Wayne ('431) discloses a heatable mixer (including A and optionally D and E), drying and cooling equipment, filters (G) and discharge equipment (for example 47,47a), wherein the heatable mixer is connected to a dryer/cooler (L) and the dryer/cooler is connected by a valve system (43) to a second batch mixer (M) which has devices for adding additives (see Fig. 1). While claim 8 refers to "flour", applicant is reminded that "Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining the patent ability of the apparatus claim" *Ex parte Thilbault* 164 USPQ 666, 667 (Bd. App. 1969) and "inclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims" *In re Otto* 136 USPQ 458, 459 (CCPA 1963). Also "the manner or method in which such device is to be utilized is not germane to the issue of patentability of the machine itself" *In re Casey* 152 USPQ 235 (CCPA 1967). Regarding claim 9, the batch mixer has a device having nozzle bars (for example 17a). Regarding claims 10 and 11, as indicated by the word "steam" in several instances in the drawings, the device further comprises heating ducts. Regarding claims 12 and 13, the device further comprises additional mixers including 50, 59, 75, 87 and 100.

***Response to Arguments***

5. Applicant fails to point out any structural difference between the elected claimed device and the applied prior art. Applicant instead discusses a use of the claimed device, particularly "thermal treatment of flour for hygienic purposes". As held in *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990), "apparatus claims cover what a device *is* not what a device *does*" (emphasis in original). Also, "recitation with respect to the manner in which a claimed apparatus is intend to be employed does not differentiate the claimed apparatus from a prior art apparatus" *Ex parte Masham* 2 USPQ2d 1647, (Bd. Pat. App. & Inter. 1987). "Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining the patent ability of the apparatus claim" *Ex parte Thilbault* 164 USPQ 666, 667 (Bd. App. 1969) and "inclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims" *In re Otto* 136 USPQ 458, 459 (CCPA 1963). Also "the manner or method in which such device is to be utilized is not germane to the issue of patentability of the machine itself" *In re Casey* 152 USPQ 235 (CCPA 1967). See also *In re Schreiber* 44 USPQ2d 1429, 1431 (Fed. Cir. 1997) where a claimed device for dispensing popped popcorn one kernel at a time what held unpatentable over a reference disclosing an oil spout which mentioned absolutely nothing concerning popcorn.

***Conclusion***

6. Applicant's amendment necessitated any new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David L. Sorkin whose telephone number is 571-272-1148. The examiner can normally be reached on 9:00 -5:30 Mon.-Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda L. Walker can be reached on 571-272-1151. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David L. Sorkin
Primary Examiner
Art Unit 1723

DLS